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IN THE

Supreme Court of the United States

OCTOBER TERM, 1962

No. 796

TECHNICAL TAPE CORPORATION,
Petitioner,

vs.

MINNESOTA MINING AND MANUFACTURING COMPANY,
Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT

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Petitioner, Technical Tape Corporation, prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Seventh Circuit which was entered in the above entitled action on November 6, 1962.

Opinions Below

The Opinion of the Court of Appeals for the Seventh Circuit is reported at 309 F. 2d 55, and appears as Appendix A to this Petition. The Opinion of the District Court for the Northern District of Illinois is reported at 200 F. Supp. 753, and appears as Appendix B to this Petition.

Jurisdiction

The Judgment of the Court of Appeals was entered on November 6, 1962. The jurisdiction of this Court is invoked under 28 U. S. C. § 1254(1).

Questions Presented

1. May one Court of Appeals interpret patent claims broadly and apply the elastic "doctrine of equivalents" to find infringement by an accused structure when a prior Court of Appeals in another Circuit interprets the same patent Claims narrowly and holds a substantially similar structure not infringing?

2. Can there be infringement of a patent by a structure which accomplished what the patent asserts and claims to be impossible?

3. Is public policy served by a Court's refusing to suspend judgment in a patent case for the purpose of obtaining additional discovery, when the said patent owner has been indicted for violation of the Anti-Trust Laws of the United States regarding such patent, shortly after said patent decision was handed down but before entry of judgment?

Statute Involved

35 U. S. C. § 112 which is involved herein is printed in Appendix C to this Petition.

Statement of the Case

Petitioner, Technical Tape Corporation (hereinafter referred to as "Technical") was sued by respondent, Minnesota Mining and Manufacturing Company (hereinafter referred to as "Minnesota") in the United States District

Court for the Northern District of Illinois for alleged infringement of the Oace et al Reissue Patent No. 23,843 which will not expire until 1968. The District Court held the Oace patent valid and infringed by various rolls of tape made by Technical and the Court of Appeals for the Seventh Circuit affirmed.

Both the District Court and the Court of Appeals relied on the so-called "doctrine of equivalents" to find that the accused tapes of Technical infringed the Oace patent. In other words, these Courts applied a broad interpretation to the patent claims and stretched them to cover what they did not say.

In companion litigation on the same Oace patent and on the same issue, the Fourth Circuit Court of Appeals arrived at just the opposite result. There is a clear conflict of Circuits as to the scope of the Oace patent. The Fourth Circuit Court of Appeals in its opinions entitled *Sears, Roebuck & Co.* vs. *Minnesota Mining*, 243 F. 2d 136 and 249 F. 2d 66 (4th Cir. 1957) held that the Oace patent, by virtue of its disclosure and history in the Patent Office, is entitled only to a narrow interpretation and may not be used to monopolize subsequent discoveries of researchers such as petitioner. The Fourth Circuit stated at 243 F. 2d, 136, 142:

> "It follows that the scope of the patent in suit [Oace patent] is limited by its disclosure and may not be extended to cover what other investigators subsequently discovered."

The conflicting ruling of the Seventh Circuit is aptly summed up in its affirmance of the District Court's opinion, which stated (200 F. Supp. 763 at 759):

> "The Court concludes that the reissue [Oace patent] covers a valid, patentable invention, which is

entitled to broad interpretation and range of equivalence."

As a practical matter, the accused infringer in the *Sears* case need not pay tribute to the Oace patent when it sells rolls of tape competitive to Minnesota's, since the Fourth Circuit has construed the Oace patent literally and narrowly. In contrast, petitioner is forced to pay tribute to the Oace patent because the Seventh Circuit has a conflicting interpretation of the same patent.

The District Court's opinion was handed down on December 5, 1961. On December 13, 1961 respondent Minnesota was indicted for violation of the Anti-Trust Laws of the United States for, *inter alia*, Minnesota's conspiratorial activities and misuse of several patents including the Oace patent. Minnesota was accused of conspiring with 9 other tape companies* to monopolize the tape industry. A timely motion to suspend entry of judgment was made before the District Court. The denial of the motion was upheld by the Court of Appeals.

Reasons for Granting the Writ

This Petition seeks review of the decisions below which, on the issue of infringement of the Oace patent, are in conflict with decisions of the Fourth Circuit and the District Court of Massachusetts. The accused rolls of tape made by Technical and held to infringe below are substantially similar (in appearance, utility and physical characteristics) to rolls of tape held *not* to infringe the Oace patent in *Sears, Roebuck & Co.* v. *Minnesota Mining*, 243 F. 2d 136 and 249 F. 2d 66 (4th Cir. 1957) and in *Plymouth Rubber*

* Technical and the tape manufacturer in the *Sears* case are *not* among the named conspirators.

Co. v. *Minnesota Mining*, 203 F. Supp. 595 (D. C. Mass. 1962).

All the rolls of tape involved in these cases are black rolls of electrician's tape, commonly called vinyl tape. An ordinary purchaser could not tell one from the other.* The Seventh Circuit, ignoring the prior decision of the Fourth Circuit on the identical issue of infringement, held petitioner's tapes to be an infringement because they looked like respondent's and it brushed aside evidence which it deemed "highly technical".**

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* See testimony of respondent Minnesota's witness Danovitch at pp. 149-150 of Petitioner's Appendix below wherein Mr. Danovitch stated

"Q. Now, are you familiar with the appearance of Scotch Brand No. 33 Tape and the pressure-sensitive vinyl plastic electrical insulating tape of Plymouth Rubber Company? A. Yes.

Q. Are you familiar with the Plymouth Rubber Company's electrical insulating tape held to be a non-infringement of the Oace Patent by the Fourth Court of Appeals? A. Yes.

Q. To a user do these two tapes, namely, the Scotch and the non-infringing Plymouth tape, appear to look alike, that is, from the point of view of the user, not the manufacturer? A. Yes.

Q. Are they both stretchable? A. Yes.

Q. Are they both black? A. Yes.

Q. Do both have a pressure-sensitive adhesive on it? A. Yes.

Q. An adhesive normally tacky? A. Yes.

Q. In both instances does the adhesive offset when the tape is unwound from the roll in either instance? A. No.

Q. Are both tapes resistant to acids? A. Yes.

Q. Do they feel approximately alike? A. Very similar.

Q. Are they resistant to hydrocarbons, that is, the vinyl backing? A. Yes.

Q. To the best of your knowledge, do they both have Underwriters Laboratories approval? A. Yes."

** The District Court of Massachusetts, 203 F. Supp. 595 (1962) has followed the decision of the Fourth Circuit in the scope of the Oace patent in what it characterized as a "litany of litigation" instigated by Minnesota.

The Oace patent is of considerable commercial significance and has about 5 years of life before it expires. Meanwhile, Minnesota is apparently using it as one of its arsenal of tape patents to terrorize and intimidate the tape making indfistry to force it to bow to its dictatorial control. Respondent Minnesota stands indicted for conspiring with 9 tape manufacturers other than petitioner Technical (and Plymouth Rubber, the Fourth Circuit winner) to monopolize and regiment this important industry.

Even absent the intriguing issue of patent misuse presented in the indictment of Minnesota, this Court has announced its policy of resolving infringement conflicts between Circuits where the same patent is involved. *Universal Oil Products Co.* v. *Globe Oil & Refining Co.*, 332 U. S. 471 (1944); *Sanitary Refrigerator Co.* v. *Winters*, 280 U. S. 30 at 33, 34 (1929).

The Oace patent is on a roll of black plastic (vinyl) tape. It states that in order to make such tape commercially acceptable, two *different* kinds of softening agents (called plasticizers) must be mixed with the plastic. The patent states that use of *only one* of these two different softeners in the mix leads to a disaster called, in patent jargon, loss of "permanent equilibrium." Otherwise stated, the disaster would be lack of commercial acceptance.

One softener prescribed is called a liquid or *monomeric* plasticizer, 243 F. 2d 136, at 143. The other softener prescribed is called a resinous or *polymeric* plasticizer 243 F. 2d 136, at 143.

Petitioner, Technical found the prescription of the patent to be wholly erroneous and discovered that it could make acceptable plastic tape with only *one* of the prescribed softeners. No commercial disaster occurred.

Plymouth Rubber Co. independently learned the same thing, 243 F. 2d 136, at 140. It, too, marketed its tape. Minnesota retaliated by suing both Technical and Plymouth's customers in different Circuits.

The Fourth Circuit and the Seventh Circuit arrived at opposite conclusions to the same problem. Resolution of the issue by this Court is imperative.

Last but not least, is the failure of the Courts below to suspend judgment* until petitioner could take evidence of Minnesota's monopolization practices and conspiratorial activities with 9 other companies in the tape industry. Neither Technical nor Plymouth were members of the conspiracy and obviously could not be aware of its scope and the schemes the conspirators used to cover their tracks until the indictment was handed down, after several years of investigation by a Grand Jury. The indictment, reproduced as Appendix D herein, was handed down only a matter of days after the District Court below rendered its opinion, but before judgment.

Obviously it is of considerable importance to the purchasing public such as citizens generally, governmental agencies, schools, hospitals and industry as a whole that anti-trust combinations** should not profit from the patent laws. As the Eighth Circuit, mindful of the paramount public interest in patent litigation, sagely ruled in *Frank*

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* Petitioner moved promptly under Rule 27(b) F. R. C. P. to take depositions of the key figures in the Minnesota conspiracy pending appeal.

** The Anti-Trust violations of which Minnesota stands accused regarding the Oace patent run the gamut of possible misuses, e. g., price-fixing, patent pooling, restraint of foreign trade, rigging the market and amassing patent to dominate an industry.

Adam Electric Co. v. *Westinghouse Elec. Mfg. Co.*, 146 F. 2d 165 (8th Cir. 1949):

> "Where the public interest is involved, as it is in a patent infringement case the admissibility of such evidence [of anti-trust violation] does not depend upon the diligence or want of diligence of a party to the case. * * * the court should inquire into the facts of its own accord, and if it finds the charge to be true relief should not be granted."

This Court ruled in *Hazel-Atlas Glass Co.* v. *Hartford-Empire Co.*, 322 U. S. 238, at 246 (1944) that: "There are issues of great moment to the public in a patent suit." In that case, as stated at pp. 241-242 of 322 U. S., the attorneys for the losing defendant in a patent infringement suit had some clues that the patent owner had unclean hands "but relied upon other defenses." It was after such defendant lost an appeal that it pursued a further investigation of the unclean hands. Even this proved abortive. Years later a Grand Jury indictment of the patent-owner unearthed some of the facts concerning the unclean hands. The patent-owner relied on every procedural trick to keep the ill-gotten fruits of its patent victory. The lower courts permitted this. This Court did not.

Conclusion

For the above reasons, petitioner prays that a Writ of Certiorari be granted.

Respectfully submitted,

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